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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,128	11/18/2003	Andreas Gerken	GERKEN ET AL.-1	7013
25889	7590	03/22/2006	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			MUSSEY, BARBARA J	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/716,128		GERKEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Barbara J. Musser		1733	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 14-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/18/03, 1/21/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 25-38, drawn to a method of making a molded body, classified in class 156, subclass 78.
  - II. Claims 14-22, drawn to a device for manufacturing a molded body, classified in class 428, subclass 141.
  - III. Claims 23 and 24, drawn to a molded body, classified in class 428, subclass 156.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to practice a different process such using the elastic skin to as apply texture to a paper slurry to form a textured paper.
3. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as applying the texture to the mold rather than using a flexible layer.

4. Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product can be made by a different apparatus such as one wherein the texture is applied to the mold rather than using an elastic skin having graining.

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species: Species A: forming the molded body by back-foaming to form the base and Species B: forming the molded body by joining a preformed base. The species are independent or distinct because they cannot be practiced together. Species B has two sub-species: 1: bonding the film and base using an adhesive and 2: bonding the film and base autogenously.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

7. During a telephone conversation with Liz Richter on 3/15/ a provisional election was made with traverse to prosecute the invention of group I, species I, claims 1-4 and 7-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5, 6, and 14-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 1-4 and 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear what is meant by inserting the elastic skin "into a receiving mold open on one side of a tool bottom part" in lines 5-6. For the purposes of examination, this is considered to mean that the receiving mold has a bottom part since applicant's figures do not show the bottom mold part being open on a side other than the top. It is unclear how the intermediate space can be defined by the tool top part and yet be sealed off from the top tool part as required by step (d). For the purposes of examination, it is assumed that the top mold part has a layer attached thereto which can become part of the final product. It is unclear if the reactive foaming agents in step (d) refers to a mix of reactive materials which react to form a polymer mixed with a foaming agent of some sort or if they require a foaming agent that reacts, i.e. by a chemical reaction, to form a foam. For the purposes of examination, it is assumed that it refers to a mixture of compounds which react to form the polymer combined with a foaming agent of some sort.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 2, 10, and 12 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by, or in the alternative under U.S.C. 103 as obvious over Malfliet et al.(WO 02/26461A1).

Malfliet et al. discloses a method of forming a molded body by inserting an elastic skin(6) having a graining(7) on the inside into a receiving mold bottom(2,3,4), the edges of which stabilize the elastic skin(Figure 1), applying a liquid polymer to the inside of the elastic skin which is hardened to form a molded skin(9), back foaming the mold by introducing a foamable mixture into the mold, the foam location delimited by the upper and lower mold parts(2, 3, 4, 11), the upper mold having a support(10) covering its surface such that the foaming space is cut off from the tool top part during molding(Figure 3), removing the elastic skin(6), molded skin(9), and foamed body(12) from the mold as a unit attached to the tool top(Figure 11), and stripping the elastic skin from the molded skin so that graining remains on the molded skin.(Figure 7; Abstract; Pg. 6, ll. 12-13, 26-Pg. 7, ll. 1, 8-11; Pg. 10, ll. 13-20) The reference indicates a pre-determined skin thickness.(Pg. 8, ll. 18-23) The reference does not disclose the foamable material comprises reactive foaming agents. However, for a material to foam, there must be some type of foaming agent. Therefore, the reference is considered to teach reactive foaming agents.

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In the event that it does not, alternatively, since the reference discloses both the skin(9) and support(10) can be made from reactive mixtures(Pg. 9, ll. 16-23; Pg. 10, ll. 25), one in the art would appreciate that the foaming composition could be made of reactive components since such is well-known and conventional method of making a polymer.

Regarding claim 10, the film is made from polyurethane and is therefore considered a polyurethane molding resin.(Pg. 8, ll. 18-20)

Regarding claim 12, Malfliet et al. discloses a paint film can be applied to the inside of the elastic skin after it is placed in the mold.(Pg. 8, ll. 1-3)

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 7, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malfliet et al.(WO 02/26461A1) as applied above.

Regarding claim 7, while the reference does not disclose re-using the elastic skin, one in the art would appreciate that since it was made of the same materials as applicant's, i.e. silicone, in the same way, that it would also be capable of being reused and that one in the art seeking cost efficiency, would re-use the skin.



Regarding claim 8, Malfliet et al. discloses injecting or pouring the molded skin resin(Pg. 6, ll. 25-28). The mold space when the mold is closed is defined by the elastic skin(6) and the top tool part(12). While the reference does not specifically disclose the support is on the top tool part when the mold is closed, since the molded skin is near the support in places(Figure 4) one in the art would appreciate that the support would be on the top tool part when the resin is injected into the closed mold so that the skin would not be thicker than the article is intended to be in the narrower locations.

Regarding claim 10, the film is made from polyurethane and is therefore considered a polyurethane molding resin.(Pg. 8, ll. 18-20)

Regarding claim 12, Malfliet et al. discloses a paint film can be applied to the inside of the elastic skin after it is placed in the mold.(Pg. 8, ll. 1-3)

Regarding claim 13, while Malfliet et al. does not disclose that different part of the elastic skin can be painted different colors, one in the art would appreciate that different regions could be painted different colors so the final article would have different colors in different locations.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malfliet et al. as applied to claim 1 above, and further in view of Jourquin et al.(U.S. Patent 5,662,996).

The reference cited above does not disclose whether the foam is open or closed cell, but does indicate the foam is made of polyurethane.(Pg. 10, ll. 20) Jourquin et al. discloses forming an article having a polyurethane skin and a polyurethane foam in a mold wherein the foam is an open-cell foam.(Abstract; Col. 4, ll. 22-23) It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to make the foam of Malfliet et al. open cell since Jourquin et al. shows that articles made of similar materials in similar ways use an open cell foam.(Col. 4, ll. 22-23)

16. Claims 4, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malfliet et al. as applied to claims 1 and 8 above, and further in view of Staneluis et al.(U.S. Patent 4,925,719).

Malfliet et al. is silent as to whether the mold top is heated. Staneluis et al. discloses a method of making a polymeric article with a polyurethane skin and a polyurethane foamed core in a mold(130,132) wherein the molds are heated.(Col. 1, ll. 12-15; Col. 7, ll. 8-10) It would have been obvious to one of ordinary skill in the art at the time the invention was made to heat either the top or bottom part of the mold of Malfliet et al. since the reference does not disclose whether the mold is heated or not and since heating aids in the curing and foaming of resins as shown for example by Staneluis et al. which discloses heating the mold.(Col. 7, ll. 8-10)

Regarding claim 11, while Malfliet et al. does not disclose whether the polyurethane is thermoplastic or thermosetting, since the polymer can only be either single or multi component and either based on aliphatic or aromatic starters as there are no other alternatives, the reference is effectively considered to teach these limitations. Staneluis et al. discloses the skin layer can be a thermoset polyurethane.(Col. 2, ll. 25-26) It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the molded skin of Malfliet et al. thermosetting since

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Staneluis et al. discloses that articles made with polyurethane skins and polyurethane foams cores in molds can have thermosetting skins.(Col. 1, ll. 12-15; Col. 2, ll. 25-26)

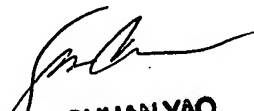
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJM



**SAM CHUAN YAO**  
**PRIMARY EXAMINER**